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REMARKS

By this Amendment, Applicants have amended claims 69-72, 90, and 91. Claims 69-108 are currently pending in this application. Claims 69, 82, and 94 are independent claims.

Initially, Applicants thank the Examiner for apparently withdrawing the Restriction and Election of Species Requirements dated September 30, 2002 and examining all the pending claims 69-108. Applicants also thank the Examiner for indicating that claims 82-108 are allowable and that claims 73-75 contains allowable subject matter.¹ See Office Action, page 4.

Applicants respectfully request that the Examiner formally acknowledge Applicants' claim of benefit under 35 U.S.C. § 120. As indicated on the Transmittal Letter filed on June 27, 2001, Applicants claimed the benefit of the U.S. Application No. 09/710,884, filed November 14, 2000, which is a continuation of U.S. Application No. 09/150,181, filed September 10, 1998, now U.S. Patent No. 6,196,230. To make the record clear, Applicants respectfully request that the Examiner formally acknowledge Applicants' claim of benefit under 35 U.S.C. § 120 in the next communication.

In the Office Action, claims 71, 72, 90, and 91 were rejected under 35 U.S.C. § 112, first paragraph, as being indefinite. See Office Action, page 2. By this Amendment, Applicants have replaced "a first wall" and "a second wall" recited in claims 70-72 with "a first wall portion" and "a second wall portion," respectively, and have

¹ In the Office Action, the Examiner indicated that claims 90 and 91 were allowed, but also rejected those claims under 35 U.S.C. § 112, first paragraph. Claims 90 and 91 have been amended to obviate the Section 112 rejection of those claims, so, whether or not the Examiner's previous indication of allowability was intended, those claims should now be in condition for allowance.

amended claims 90 and 91 to recite a "wall portion." The amendment to claims 70-72, 90, and 91 do not narrow the scope of those claims, but rather merely clarify the claim language. Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 112, first paragraph.

In the Office Action, claims 69-72, 76-78, 80, and 81 were rejected under 35 U.S.C. § 102(e) as being anticipated by Makower et al. (U.S. Patent No. 6,302,875); claims 69, 70, 77, and 78 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ohshiro (U.S. Patent No. 4,040,413); and claim 79 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Makower et al.

Applicants respectfully traverse the various claim rejections based on Makower et al. and Ohshiro for the reasons explained below.

Makower et al. fails to disclose or otherwise suggest each and every limitation recited in independent claim 69, as amended. See M.P.E.P. § 2131 (8th Ed., Aug. 2001). For example, Makower et al. fails to disclose a delivery catheter comprising, among other things, "a steering member . . . configured to cooperate with a body lumen to turn the distal end of the catheter," as recited in independent claim 69.

As shown in Figs. 2-2c', on which the Examiner relies in the Office Action, Makower et al. discloses an anchorable guide catheter 50 having a proximal end PE and a distal end DE. See col. 8, lines 32-35. The anchorable guide catheter 50 of Makower et al. further includes a balloon 59 mounted on the catheter body 52. See col. 8, lines 37-40. In col. 9, lines 54-59 and Fig. 2a', Makower et al. discloses that "the balloon 59 of the guide catheter 50 will be inflated . . . to engage the surrounding luminal anatomical wall and to hold the distal portion of the guide catheter 50 in

substantially fixed longitudinal and rotational position/orientation." However, nowhere in Makower et al. is it disclosed or otherwise suggested that either the balloon 59 or any other structure associated with the guide catheter 50 cooperates with a body lumen to turn the distal end DE of the guide catheter 50. The other embodiments disclosed in Makower et al. also fail to disclose or otherwise suggest "a steering member," as recited in claim 69. For at least this reason, independent claim 69, and its dependent claims 70-81, are patentably distinguishable from Makower et al.

Ohshiro also fails to disclose each and every limitation recited in independent claim 69, as amended. See M.P.E.P. § 2131 (8th Ed., Aug. 2001). For example, Ohshiro fails to disclose a delivery catheter including, among other things, "a steering member . . . configured to cooperate with a body lumen to turn the distal end of the catheter," as recited in independent claim 69.

Referring to Figs. 1-3, Ohshiro discloses an endoscope including a light transmitting tube 1 composed of a soft rigid sleeve 11 and a flexible sleeve 12 connected with the soft rigid sleeve 11. See col. 2, lines 38-42. In col. 2, lines 62-65, Ohshiro further discloses that remote control wires (not shown in the drawings) in the tube 1 bend the flexible sleeve 12. Ohshiro also discloses that the tube 1 includes three balloons 17a-17c around the soft rigid sleeve 11. When inflated, as shown in Fig. 2, the balloon 17a forces the tube toward one side of the intestinal wall 20 and expands the wall 20 to enlarge the space within the intestine. Col. 3, lines 23-27.

In the rejection based on Ohshiro, the Examiner equated Ohshiro's control wires with Applicants' recited sleeving member and Ohshiro's balloon 17a with Applicants' recited anchoring member. However, the remote control wires of Ohshiro are provided

in the tube 1 and Ohshiro neither discloses nor otherwise suggests that the control wires cooperate in any way with a body lumen to turn the distal end of the light transmitting tube 1. For at least this reason, independent claim 69, and its dependent claims 70-81, are patentably distinguishable from Ohshiro.

Claims 70-81 depend from independent claim 69, and therefore, as discussed above, are allowable for at least the same reasons as claim 69. Additionally, each of dependent claims 70-81 recites unique combinations that are neither taught nor suggested by the cited art and therefore each also is separately patentable.

The Office Action contains various characterizations and assertions regarding Applicants' claims and the art, including, for example, the assertions of obviousness set forth in the Section 103 rejection and the assertions set forth in the Examiner's Statement of Reasons for Allowability, both at page 4 of the Office Action. Applicants do not necessarily agree with those various characterizations and assertions. Unless expressly noted otherwise, Applicants decline to subscribe to any characterization and/or assertion in the Office Action.

In view of the foregoing, Applicants respectfully request formal acknowledgement of Applicants' claim of benefit under 35 U.S.C. § 120, the withdrawal of the outstanding claim rejections under 35 U.S.C. §§ 102, 103, and 112, first paragraph, and timely allowance of claims 69-108.

Applicants attach hereto an Appendix presenting marked-up version of the claims showing the changes made by this Amendment. Deletions appear as normal text surrounded by [] and additions appear as underlined text.

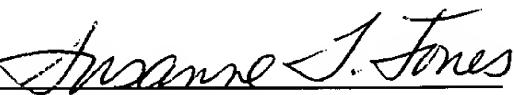
Application Number: 09/891,663
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Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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APPENDIX

This Appendix is being provided in accordance with the provisions of 37 C.F.R. § 1.121(c)(1)(ii). This Appendix is not intended to form part of the application.

Amendments to the Claims:

69. (Amended) A delivery catheter, comprising:
an elongate tubular body having a proximal end and a distal end and a lumen extending between the proximal end and the distal end;
an anchoring member mounted proximate the distal end of the tubular body; and
a steering member mounted proximate the distal end of the tubular body at a position distal to the anchoring member, the steering member being configured to cooperate with a body lumen of a patient to turn the distal end of the catheter.

70. (Amended) The catheter of claim 69, wherein the anchoring member is configured to engage a first wall portion of [a] the body lumen to secure the catheter within the body lumen.

71. (Amended) The catheter of claim 70, wherein the steering member is configured to cooperate with a second wall portion of the body lumen to turn the distal end of the catheter.

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72. (Amended) The catheter of claim 71, wherein the steering member is configured to engage with the second wall portion of the body lumen at a location substantially opposite to the first wall portion with which the anchoring member engages.

90. (Amended) The method of claim 82, wherein actuating the steering member to cooperate with the body lumen includes engaging the steering member with a [second] wall portion of the body lumen.

91. (Amended) The method of claim 90, wherein the engaging the steering member with a [second] wall portion of the body lumen causes the distal end of the tubular body to turn in a direction away from the [second] wall portion.

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